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OFFICE OF PETITIONS

In re Patent No. 6,859,309 : DECISION ON REQUEST
Fischer et al. : FOR RECONSIDERATION OF
Issue Date: February 22, 2005 : PATENT TERM ADJUSTMENT
Application No. 10/028,601 : and
Filed: December 19, 2001 : NOTICE OF INTENT TO ISSUE
Atty Docket No. 55841US002 : CERTIFICATE OF CORRECTION

This is a decision on the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT, filed March 23, 2005. Patentees request that the patent term adjustment as indicated in the Issue Notification be corrected from twenty-seven (27) days to one hundred ninety-one (191) days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED to the extent indicated herein.**

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **fifty-five (55)** days.

On February 22, 2005, the application matured into U.S. Patent No. 6,859,309, with a revised patent term adjustment of 27 days. On March 23, 2005, patentees timely submitted this request for reconsideration of patent term adjustment (with required fee), requesting that the Patent Term Adjustment be extended to 191 days. Patentees assert that the patent is entitled to 191 days of PTA on the basis that the Office failed to issue the patent within four months of the payment of the issue fee and satisfaction of all outstanding requirements. This is the sole basis for correction asserted by patentees. Patentees' argument has been considered, but not found persuasive. Patentees are advised that the PTA of 27 days

indicated on the Issue Notification (and on the patent) properly includes entry of a period of adjustment of 192 days for the delay cited by patentees. Thus, patentees' argument is moot.

Nonetheless, a review of the application history reveals that pursuant to 37 CFR 1.704(c)(10)¹ and considering the period of overlap², periods of reduction of 28 days and 120 days were entered for applicants' filing respectively of an IDS on March 3, 2004 and of a miscellaneous incoming letter on March 31, 2004. (Reconsideration of these periods of reduction is timely under 1.705(d)). A reduction for the filing of the IDS is warranted.

However, as stated in MPEP 2732:

Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). The submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" and (7) letters related to government interests (e.g., those between NASA and the Office).

A review of the letter filed March 31, 2004 reveals that it was a "Comments on Statement for Reasons of Allowance," as provided

¹ 1.704(c)(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or (ii) Four months.

² Since the Office's response to both papers was mailed on November 30, 2004, the period of overlap is March 31, 2004 to November 30, 2004.

for in 6 above. Thus, no reduction was warranted. It is further noted that under the circumstances, no reduction is warranted for the paper filed April 13, 2004. As the IDS was filed after the mailing of the notice of allowance, this was the first opportunity for patentees to request a signed 1449 with respect to the IDS filed March 3, 2004.

Accordingly, the only basis for reduction pursuant to 1.704(c)(10) is the filing of the IDS on March 3, 2004. There is no overlap. Thus, the period of reduction is the lesser period of four months (120 days), rather than the non-overlapping period of 28 days. In other words, the period of reduction of 28 days associated with this paper is removed and a period of reduction of 120 days is entered.

Patentees are reminded that for full consideration all grounds for correction of the PTA (that are timely subject to consideration) should be included in any 1.705(b) or (d) filing.

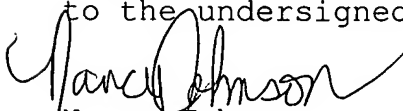
In view thereof, the patent should have issued with a patent term adjustment of fifty-five (55) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The fee is required and will not be waived.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **FIFTY-FIVE (55)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.


Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Attachment: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 6,859,309 B2
DATED : February 22, 2005
INVENTOR(S) : Fischer et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (27) days

Delete the phrase "by 27" and insert – by 55 days--